Remarks

The Rejection under 35 USC Section 102(b) over Leal

In the parent application, the Examiner has rejected claims 1-3 and 18-19 as anticipated under 35 USC Section 102(b) by Leal. In the present application claims 14–18 correspond to claims 15–19 of the parent app·lication, and will be referred to herein as claims 14–18. Re consideration of the rejections of the corresponding claims in the parent application is requested in view of the amendments and remarks herein.

The rejection over Leal is respectfully traversed. In order to anticipate, the cited reference must disclose each and every limitation of the claimed invention. Leal fails to do so, and as a result Leal cannot be deemed a reference that anticipates claims 1-3 and 18-9, or any claims dependent therefrom.

Leal discloses and claims a method of constructing a "finite universe" data base of businesses, which includes identifying information and a number of predetermined characteristics for each listed business. Leal does not disclose the additional step of providing a controlled vocabulary word group for each category that vary the scope of the search within that category, and which can be separately and sequentially substituted in a series of searches as claimed in claims 1 and 18, and claims dependent therefrom. Claim 1 has been amended to further highlight this aspect of the claimed invention that is one distinction over Leal. Claims 17-18 have been amended to expressly incorporate this limitation as one patentable distinction over Leal.

The distinction is important, and is not disclosed or suggested by Leal because of the fundamental differences between the methods of Leal and the claimed invention. Leal

also fails to disclose or suggest the varying of one of the group of controlled vocabulary word within at least one category, and conducting a second search in the same search topic, transmitting the second search, and receiving a second data set.

In Leal, the database is structured with a predetermined, finite number of pre-defined categories. The search engine's only purpose is to identify businesses to a user that correspond to the user's needs as defined and limited by the predetermined categories. Accordingly, the search engine includes provisions only for selecting among the predetermined categories, and does not include the additional, unnecessary step of providing for each predetermined category a controlled vocabulary of search terms that vary the scope of the search within the category, and which can be sequentially substituted in an iterative search process.

This distinction is highlighted by the fact that Leal nowhere discloses or suggests an iterative search process to produce multiple data sets where each category includes a controlled vocabulary of related terms associated with the particular category, and which have been selected to vary the scope of the search in an iterative search process. The substitution of search terms from the controlled vocabulary within a category, and conducting a second search directed toward the same area of interest to retrieve a second data set, is another limitation of the claimed method that is simply not disclosed by Leal, and would not be suggested by Leal for the reasons discussed above – the predet ermined, single level categories and information in the database of Leal simply do not provide for varied searches *within* each category, and do not because there is no further benefit to repeated searches of the same single level categories in Leal.

10

By contrast, the claimed invention provides numerous advantages in searching non-finite data sources or universes, such as the world wide web, where the contents and structure of the data source or universe is not finite and are not organized into predetermined categories,. As a result many aspects of its overall contents and structure are not and cannot be known to the searcher. The claimed invention provides a controlled vocabulary in each category that is selected to anticipate the varying scope of terms within each category that different data sources might include, and provides an ordered, structured method of performing the numerous iterative searches required to search the entire data source by substituting each of the controlled vocabulary terms in each category. Only in this way can one be certain of performing a thorough search of a data source, the structure and content of which is either unknown, or which is not structured by predetermined categories, and therefore cannot be effectively searched by the methods disclosed and suggested by Leal.

Since Leal fails to disclose each and every limitation of any claims 1-3 and 17 – 18, Leal is not a reference that anticipates any of the subject claims under 35 USC Section 102(b).

The Rejection of Claims 4 – 6 and 17 – 18 under 35 USC Section 103(a) over L eal in view of Jakob Ziv-El

As discussed in detail above, Leal fails to disclose or suggest each of the limitations of claim 1, and therefore cannot and does not disclose or suggest each limitation of claims 4-6, 11 and 13 which are dependent therefrom. As a result, unless Jakob Ziv-El discloses or suggests modifying Leal to achieve the invention of claims 4 – 6, 11 and 13, including

providing those limitations absent from Leal, the Examiner has not made a prima facie case of obviousness under Section 103(a).

The Examiner nowhere cites Jakob Ziv-El as disclosing or suggesting the claim limitations absent from Leal discussed above, which remarks directed thereto are incorporated into applicant's remarks in this section. Applicant's close review of Jakob Ziv-El fails to reveal 1) any suggestion to apply its teachings directed to an "on-line teaching and learning" apparatus and method to the search methods of the claimed invention, or; 2) any disclosure of limitations of claim 1 absent from Leal as discussed above. Therefore, there is no suggestion of record to combine Jakob Ziv-El with Leal as required, and, even if the teachings of Jakob Ziv-El are applied to Leal as suggested by the Examiner but not otherwise, one would not achieve the invention claimed in any of claims 4–6. Therefore, a prima facie case of obviousness has not been made, and the Examiner's rejection is deemed traversed.

The Rejection of Claims 7–10, 12, and 15 under 35 USC Section 103(a) over Le al in View of Marchisio

As discussed in detail above, Leal fails to disclose or suggest each of the limitations of claim 1, and therefore cannot and does not disclose or suggest each limitation of claims 7–10, 12, or 15, each of which are dependent therefrom. As a result, unless Marchisio discloses or suggests modifying Leal to achieve the invention of claims 7–10, 12, or 15, including those limitations absent from Leal, the Examiner has not made a prima facie case of obviousness under Section 103(a).

A close examination of Marchisio fails to reveal each limitation of claim 1, or any of claims 7–10, 12, or 15 . Marchisio is directed toward a system that performs a mathematical analysis of search results to determine degrees of variance from a search query. Marchisio nowhere suggests modifying Leal to achieve the invention of the subject claims. Moreover, even if some suggestion were deemed present in the record, Marchisio nowhere discloses or suggests the limitations of any of claims 1, 7–10, 12, or 15 which are absent from Leal. Therefore, even if combined with the teachings of Leal, one would not achieve the invention of any of the subject claims, and the cited references are not sufficient to make a prima facie case of obviousness.

The Rejection of claims 15 - 16 under 35 USC Section 103(a) over Leal in view of Drucker

As discussed in detail above, Leal fails to disclose or suggest each of the limitations of claim 1, and therefore cannot and does not disclose or suggest each limitation of claims 16 or 17, each of which are dependent therefrom. As a result, unless Drucker discloses or suggests modifying Leal to achieve the invention of claims 16 or 17, including those limitations absent from Leal, the Examiner has not made a prima facie case of obviousness under Section 103(a).
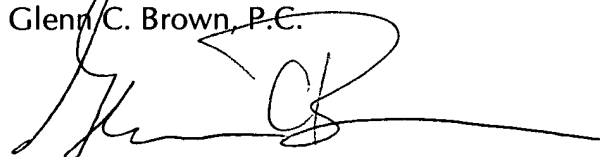
Drucker is cited for its disclosure of a search save button. Applicant does not contest that teaching of Drucker, but again points out that the Examiner does not cite Drucker for its teaching or suggestion of any other limitation of claim 1 which are absent from Leal. Applicant's close review of Drucker fails to reveal any such disclosure or any suggestion to modify Leal to incorporate the teachings of Drucker. Therefore, even if one were to modify Leal according to the teachings of Drucker, one would not achieve the

invention of either claim 16 or 17, and a prima facie case of obviousness has not been made. The Examiner's rejection is therefore deemed traversed.

Conclusion

Preliminary amendment is made herein. No fees are believed to be required. Entry and consideration of this Preliminary Amendment is respectfully requested. Applicant submits that the rejections of record in the corresponding claims of the parent application have been traversed in light of the foregoing amendments and claims, and that the claims are in condition for allowance. A Notice of Allowability is respectfully requested. The Examiner is requested to contact the undersigned if doing so would advance prosecution of the case.

Respectfully submitted,
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